

## **REMARKS/ DISCUSSION OF ISSUES**

In the present Amendment, Claims 36-42 have been amended. No new matter has been added. Claims 22-42 are pending.

### **I. Objection to the Specification**

The present Office Action objects to the specification for failing to provide proper antecedent basis for the claimed subject matter. In particular, the Examiner asserts that the term “computer-usable” in Claims 36-42 is not found in Applicants Specification. In response, Applicants have amended independent claim 36 to replace the phrase “computer-usable medium” with the following: “A computer program product for improving efficiency of file receipt in a communication program....” Support for the above amendment is found in Applicant Specification, ¶[0010], lines 1-4 and ¶[0025], lines 1-7 of Applicants’ published application. In addition, dependent claims 37-42 have replaced the phrase “computer-usable medium” with the phrase “computer program product”.

Moreover, Applicants have amended independent claim 36 to recite the element: “a tangible, computer storage medium embodying computer program code, said computer program code including computer-executable instructions configured for:...” (underlined emphasis added) Support for this amendment is described in ¶[0020] (“storage unit 110 for storing items of data or instructions for use by processing resource 108.”) and [0041] of Applicants’ published application (“recordable type media such as floppy disks or CDROMs...”)

### **II. Claim Rejection Under 35 U.S.C. § 103**

#### **A. General requirements for a claim rejection under 35 U.S.C. § 103**

According to 35 U.S.C. § 103(a):

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

To make the obviousness determination, the U.S. Supreme Court held in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) that three factors must be considered:

- (1) the scope and content of the pertinent prior art;
- (2) differences between the pertinent prior art and the invention at issue; and
- (3) the ordinary level of skill in the pertinent art.

The U.S. Supreme Court clarified in *KSR Intern. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 that a non-obviousness determination must include an inquiry as to “whether the improvement is more than the predictable use of prior art elements according to their established functions.” Also, the Court in *KSR* stated that:

[I]t will be necessary for the court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having the ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

However, the Court in *KSR* emphasized that “the analysis [of non-obviousness] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take into account of the inferences and creative states that a person of ordinary skill in the art would employ”.

#### **B. Rejection of Claims 22-42 under 35 U.S.C. § 103(a)**

In the present Office Action, Claims 22-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tormey et al.* (U.S. Pub. No. 2005/0071239 – hereinafter referred to as “*Tormey*”) in view of *Greenwood* (U.S. Patent No. 6,675,212 – hereinafter referred to as “*Greenwood*”), in further view of *Holt et al.* (U.S. Patent No. 6,601,061 – hereinafter referred to as “*Holt*”). After careful consideration of Examiner’s rejection, Applicants assert that Claims 22-42, as now amended, are not rendered unpatentable by the combination of *Tormey*, *Greenwood*, and *Holt* in view of the arguments herein.

## **1. Rejection of independent Claims 22, 29, and 36**

### **a. Scope and content of the prior art**

*Tormey* discloses utilizing a web-based search engine and receiving a listing. *Tormey*, paragraph 5, lines 7-9 and Figure 1A, reference number 20, paragraph 43, lines 1-22, and paragraph 44, lines 1-2. *Tormey* also discloses allowing a user to elect the receipt of the search results via an e-mail message. *Tormey*, paragraph 83.

*Greenwood* discloses a system and method for improving data browsing efficiency in computer implemented data browsing systems. *Greenwood*, col. 3, lines 51-52. The invention enables automatic continuation of a data browsing session when a download of a requested data file is temporarily delayed. *Greenwood*, col. 3, lines 53-55. In particular, data requests are monitored for excessive delay. *Greenwood*, col. 3, lines 55-57. The reasonable time frame for determining a temporary delay is separately programmable by the user. *Greenwood*, col. 7, lines 42-46. When the delay is identified as temporary, the download of the requested data file is handled by a separate monitoring task, set to run in the background, while active control of the data browsing session is returned to a user. *Greenwood*, col. 3, lines 58-62.

*Holt* discloses a system and method for augmenting searching for data with public search engines, by submitting searches to special purpose search resources, such as search capabilities provided by private companies, universities, government web pages, and the like. *Holt*, abstract. A search request is received 300 from a user, causing a receiving search server 102 to initialize a search thread for each special purpose search resource to be used towards completing the search request. Associated with each such special purpose search resource is a characteristic profile indicating how to effect a search with the special purpose search resource. Based on the characteristic profile, the user's received 300 search query is converted (if required) into a format suitable for the selected 302 search resource. *Holt*, col. 5, lines 11-25. The converted query is submitted 304 to the special purpose search resource. According to one embodiment, an automatic system is used by a search server to monitor special purpose search resources to identify when the special purpose search resources appear to be off-line or otherwise unavailable. After submitting 304 the search query, a time out test 306 is performed. Notably, the time out test 306 (e.g., a waiting period timeout loop) is used to determine whether the results to the

search were received within a certain timeout period. *Holt*, col. 5, lines 26-40. (underlined emphasis added)

**b. The claimed invention is distinguishable from the prior art**

Applicants respectfully submit that nothing in *Tormey*, *Greenwood*, and/or *Holt* discloses or suggests:

“in response to said first file not being received, said communication program determining whether a predetermined length of time specified in response to a timeout query has expired; and in response to determining a predetermined length of time specified in response to said timeout query has expired, and upon receipt of said first file by said communication program, encapsulating said first file in a message transmission and redirecting and redirecting said message transmission to said mail server...”,

as recited in exemplary Claim 22 (and similarly in claims 29 and 36).

By Examiner’s own admission (page 4, 1<sup>st</sup> full paragraph of Final Office Action), *Tormey* and *Greenwood* do not explicitly teach the above limitation recited in exemplary Claim 22.

In response, however, the Examiner has now cited *Holt* for the purpose of showing that a “timeout period” is taught according to Applicants’ independent claims 22, 29, and 36. According to *Holt*, col. 5, lines 33-36, “after submitting 304 the search query, a time out test 306 (e.g., a waiting period timeout loop (not illustrated) is performed to determine whether results to the search were received within a certain timeout period.”

However, *Holt*’s “time out test” waiting period is more akin to the “user increment period” recited in Applicants’ claims. Applicants’ “user increment period” is the time during which the system waits to receive a response to an issued search query (*see* Applicants’ Specification, ¶[0031]; step 310, FIG. 3). Similarly in *Holt*, the time out test 306 (e.g., a waiting period timeout loop) is used to determine whether the results to the search were received within a certain timeout period. *Holt*, col. 5, lines 33-40. (underlined emphasis added)

Assuming correctly that *Holt*’s “time out test” period is equivalent to Applicants’ “user increment period”, *Holt* also fails to teach or suggest the possibility of measuring a second, separate time period which is provided in response to the expiration of a timeout query.

In summary, *Holt* does not appear to teach or suggest that there are two distinct and separate time periods that are measured:

(1) a user increment period that the system waits to receive a response to a search query, and if a response from a search query has not been delivered to a browser within the user increment period; and

(2) a predetermined length of time specified in response to the expiration of a timeout query (element 210 in Applicants' FIG. 2A).

Support for the above assertion can be found in Applicants' published application, paragraph [0033]:

"Returning to block 304, if the option to forward response 132 to mail server 104 is detected, the process next moves to step 310, which depicts data processing system 102 waiting during a period, called a user increment, for receipt of response 132. The user increment is a length of time, separate from and generally shorter than, but potentially identical to the amount of time provided in response to timeout query 210." (emphasis added)

Furthermore, Applicants invention teaches that after period (2) (*discussed above as period (2)*) has expired, a user is then prompted to select a preconfigured email account for delivery through the presentation of a prompt:

"If there was a timeout, then a counter of the number of timeouts for the special purpose search resource is incremented 312. If 314 there were too many timeouts, e.g., 25, for the search resource, then the special purpose search resource is **removed** 316 from the collection of available (e.g., identified) search resources." (§[0036] of Applicants' published application, lines 1-7; underlined and boldfaced emphasis added).

In contrast, *Holt* teaches that if there were too many user increment periods (called "timeouts" in *Holt*), then the search resource is removed altogether, which runs contrary to what is taught in Applicants' invention.

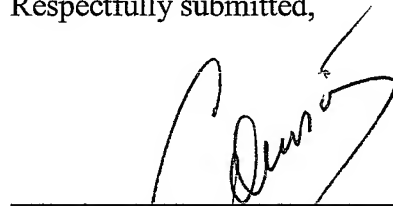
Therefore, in view of the aforementioned arguments, Applicants submit exemplary independent Claim 22, similar independent Claims 29 and 36, and all dependent claims (Claims) are not rendered unpatentable by the combination of *Tormey*, *Greenwood*, and/or *Holt* under 35 U.S.C. § 103(a). Moreover, Applicants submit that all dependent Claims 23-28, 30-35, and 37-

42 are patentable at least by virtue of their dependence upon an allowable base claim 22, 29, or 36. Applicants respectfully request that the rejection be withdrawn.

### CONCLUSION

No extension of time for this response is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application to **IBM Corporation Deposit Account Number 09-0447**.

Respectfully submitted,



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